

REMARKSStatus

Applicants appreciate the time and thorough consideration of the Examiner in the examination of this application.

All claims stand rejected. Claims 1, 3, 5, and 7, and 9-11 stand rejected as allegedly obvious under 35 U.S.C. 103(a) over Peak (U.S. Patent 5,237,605) in view of Koyama (U.S. Patent 5,654,957) and further in view of allegedly well known prior art. Claims 4, 6, and 8 stand rejected as allegedly obvious under 35 U.S.C. 103(a) over Peak (U.S. Patent 5,237,605) in view of Koyama (U.S. Patent 5,654,957) and further in view of two pieces of allegedly well known prior art.

Previous Request

In the previous response to the Office Action, the following request was asked of the Examiner: “[t]he Examiner is hereby requested under M.P.E.P. 2144.03 to provide indicia of the applicability of the included missing portion[s].” The current Office Action contains several mentions of 2144.03, but the Examiner has failed to include the requisite art as required by the section. Again, Applicants respectfully request pursuant to 2144 such indicia, aside from the bald recitement of the section.

Additionally, further requests are made in this Office Action based on current case law regarding the motivation to combine. Applicant hopes that these requests are not disregarded.

REJECTIONS

Standard for rejection under 35 U.S.C. 103

According to the Manual of Patent Examining Procedure (M.P.E.P.),

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest *all the claim limitations*. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.” (emphasis added)¹

Rejection under 35 USC 103 over over Peak in view of Koyama, and further in view of allegedly well known prior art

Claims 1, 3, 5, and 7-11 stand rejected as allegedly obvious under 35 U.S.C.

103(a) over Peak in view of Koyama, and further in view of allegedly well known prior art.

Claim 1

Claim 1 is directed to:

“a shell adapted to physically connect under a telephone, the shell having a port to connect to a telephone wire;
the shell containing interconnection logic operably connected to the port and a wire to connect to the telephone; and
a networking card in the shell for connecting to a personal computer, the networking card being operably connected to the interconnection logic, wherein digital

¹ M.P.E.P. §2143

data from the network card and voice data from the telephone can be alternately sent across the telephone wire.”

The rejection of Claim 1 does not meet the prima facie case for at least two reasons. The cited references, which form the basis of the rejection, do not show many of the portions that make up Claim 1. Second, the motivation for combination of the at least some of the references is apparently done on a non-objective basis. Thus, the combination is improper based on the reasons cited in the Action. Accordingly, the rejection of Claim is respectfully traversed.

a. There is no “interconnection logic”.

The Examiner has cited various portions of Peak and Koyama as comprising the claimed invention. First, the invention recites Peak as having interconnection logic by equating the adjunct interface electronics of Peak to the interconnection logic.

If the Examiner will note, Peak states that the “adjunct interface module converts the telephone set interface, which connects the telephone set to a premise switching system, to a different interface ... used by ... equipment associated with the telephone set.” (Peak, abstract). Further examples of the adjunct interface electronics are shown in Peak, in which it is mentioned that the “adjunct devices” are tip-ring interface devices such as an answering machine. (Peak, column 3, lines 1- 14.)

Thus plugging the “adjunct interface module” of Peak into the smorgasborg combination in the rejection leads to an inoperable combination. The adjunct device of Peak is limited solely to analog tip-ring devices. Thus, the combination of the “adjunct

interface module” to the network card leads to an inoperable combination of the tip-ring interface attempting to generate tip-ring type voltages and signals to the attached network card, which definitely does not work in the context of the claimed invention.

b. There is no “digital data . . . and voice data from the telephone . . . alternately sent across the telephone wire.”

Claim 1 contains the portion wherein “digital data from the network card” (notably not shown in the prior art, and reserved for section c, supra) “and voice data from the telephone” is “alternately sent across the telephone wire.” In the Office Action, it is asserted that Komaya stands for this section. A closer reading of Komaya reveals that these portions are, in fact not present, and the arguments in the Office Action misrepresent Komaya.

Komaya shows a phone receiver. The phone receiver contains couplings to a voice network and a local area network. Based on the topology of the various networks, the device of Komaya routes transmissions from the receiver either over the LAN line (if the originating device is addressable by the LAN) or over the voice line (if the originating line is not reachable on the LAN.)

Accordingly, the device of Komaya alternately routes voice over one line, or digital data over another. In short, Komaya shows that digital data and voice signals are alternately sent across *different lines*. This stands in contradistinction to the current claimed invention wherein “digital data from . . . and voice data” is “alternately sent across the telephone wire.”

c. There is no motivation to combine.

Next, the Examiner takes official notice that network cards are known in the art. Ostensibly this may be so, but the standard is not whether network cards are pre-existent, but whether they are used in conjunction with the particular solution that the application envisions. Accordingly, such the mere magical mention of a network card is inappropriate, since the network card is being placed into a specific situation, that is, being used in the area where “digital data from [a] network card and voice data from [a] telephone [are] be[ing] alternately sent across [a] telephone wire [associated with a telephone unit.]” Neither piece of art even deals with sending alternate types of signals down a common line.

Turning now to the legal bases, the mere mention of the network card appears to be inappropriate. Two independent bases, and requests under these two, are now brought to the Examiner’s attention.

i. Request under *In re Ahlert* regarding the application of the network card to the claimed invention as allegedly “well known in the art.”

As for the official notice a request is formally made under MPEP 2144.03 to provide an indicia of this “obviousness”. see *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970) (“[A]ssertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work” and

“allegations concerning specific ‘knowledge’ of the prior art, which might be peculiar to a particular art should also be supported.” Furthermore the applicant must be given the opportunity to challenge the correctness of such assertions and allegations. “The facts so noticed serve to ‘fill the gaps’ which might exist in the evidentiary showing” and should not comprise the principle evidence upon which a rejection is based.) Such a citation is now demanded for the proper missing portion under *In re Ahlert*.

ii. Request under *In re Lee* regarding the combination of the cited portions to form the claimed invention.

Further, a proper motivation must also be established for the combination undertaken. See *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002) “‘The factual inquiry whether to combine references must be thorough and searching.’ It must be based on objective evidence of record.” Accordingly, the bald assertion is not enough, some objective indicia must also be present. Such a citation is now demanded for the proper indicia that suggests obviousness, under *In re Lee*.

Accordingly, the rejection of Claim 1 under 35 U.S.C. 103(a) over Peak in view of Koyama, and further in view of allegedly well known prior art does not meet the prima facie case of obviousness. In light of the shown problems with the rejection, Applicant respectfully traverses the rejection of Claim 1 under 35 U.S.C. 103(a) over Peak in view of Koyama, and further in view of allegedly well known prior art.

Claims 2, 3, and 5

Claims 2, 3, and 5 depend from Claim 1. Accordingly, Claims 2, 3, and 5 contain all the portions of Claim 1, as well as other portions not found in Claim 1. For the reasons stated above in relation to Claim 1, among others, Applicants traverse the rejection of Claims 2, 3, and 5.

Rejections over Peak in view of Komaya, in view of allegedly well-known prior art and further in view of other allegedly well-known prior art.

Claims 4 and 6

Claims 4 and 6 stand rejected as allegedly obvious under 35 U.S.C. 103(a) over Peak in view of Komaya, in view of the allegedly well known prior art cited in relation to Claim 1, and further in view of other allegedly well known prior art. Applicants also request “a reference in support of [this] position[,]” to the other other allegedly well known prior art under M.P.E.P. 2144.03.

Second, Claims 4 and 6 depend from Claim 1. The addition of the art cited in the official notice of the other allegedly well known prior art does not make up the shortcomings of the prior art with respect to Claim 1 above. Accordingly, the rejection of Claims 4 and 6 are respectfully traversed, for this reason, among others.

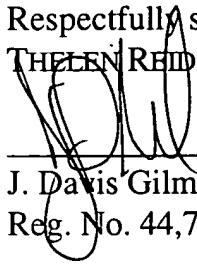
Conclusion

In view of the foregoing, consideration and an allowance of this application are earnestly solicited. It is believed that the Claims are all in form for allowance, and such a notice is asked of the Examiner. If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

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